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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,946	11/02/2001	Nilam Ruparelia	5298-06700 CD01086	4815

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EXAMINER

DERWICH, KRISTIN M

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,946

Applicant(s)

RUPARELIA ET AL.

Examiner

Kristin Derwich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/19/02.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. Claims 1-9 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Hereafter patent literature that is referenced as prior art will be cited by column and line number in the form of (column number:line number range). For example, the citation (6:23-27) refers to lines 23-27 of the 6th column in the reference.

2. Claims 1, 2, 4, 7 and 8 rejected under 35 U.S.C. 102(e) as being anticipated by Parlour et al. (Parlour), U.S. Patent No. 6,904,527.

As per claim 1:

Parlour discloses a programmable device, comprising a comparator for comparing embedded code upon the device with a software identifier placed within a program used to program the device for determining whether, when programmed, the device is configured to fall within the scope of one or more license obligations (7:55-67

wherein the UDI is the embedded code and the authorization code is the software identifier and the usage condition is the license obligation).

As per claim 2:

Parlour discloses a device, wherein the embedded code is unalterable by the user of the device (7:3-6).

As per claim 4:

Parlour discloses a device, wherein the embedded code is permanently programmed upon at least one non-volatile storage location of the device (7:8-10).

As per claim 7:

Parlour discloses a device, wherein the software identifier comprises at least one bit that signifies said one or more license obligations between a vendor or licensor of intellectual property and a manufacturer of the device (6:51-58).

As per claim 8:

Parlour discloses a device, wherein the software identifier is sent from the licensor of the intellectual property to the user of the device (6:49-54).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Parlour (U.S. 6,904,527) as applied to claim 1 above, and further in view of Allen, U.S. Patent No. 6,629,309.

As per claim 3:

Parlour fails to teach a device wherein the embedded code is conveyed from a mask to a semiconductor topography bearing the device. However, Allen discloses a device wherein an embedded identification is conveyed from a mask to a semiconductor topography (15:55-66, fig. 12).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize the mask modification invention of Allen when producing the semiconductor topography of the programmable device in Parlour because of the possibility of needing to revise the device's embedded identification. This is a very expensive and time consuming task that the invention of Allen relieves (Allen, 2:28-40).

4. Claims 5, 6 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Parlour (U.S. 6,904,527) as applied to claim 1 above, and further in view of Animi et al. (Animi), Artisan Components Free IP Business Model.

As per claim 5:

Parlour fails to teach a device wherein the embedded code comprises at least one bit that signifies said one or more license obligations between a vendor or licensor of intellectual property and a manufacturer of the device. However, Animi discloses a

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business model license obligations between (pg. 4, sec 2.2: Artisan introduces Free IP Model).

As per claim 6:

Parlour fails to teach a device wherein the embedded code is sent from the licensor of the intellectual property to the manufacturer of the device. However, Animi discloses a business model where the IP vendors collect royalties from the manufacturer based on the percentage of revenue attributed to the IP vendor's modules (pg. 4, sec 2.2: Artisan introduces Free IP Model).

As per claim 9:

Parlour fails to teach a device wherein the license obligations are royalty payments due to a vendor or licensor of intellectual property. However, Animi discloses a business model where the manufacturer pays royalties to the IP vendor (pg. 4, sec 2.2: Artisan introduces Free IP Model).

In view of the teachings of Animi, it would have been an obvious modification to the invention of Parlour et al. to have a device with a licensor provided embedded code in order to switch from a flat rate licensing fee to a royalty payment system because this would allow for the IP vendor to be able to keep track of how many devices utilized their modules when calculating the royalty payments.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristin Derwich whose telephone number is 571-272-7958. The examiner can normally be reached on Monday - Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristin Derwich
Examiner
Art Unit 2132

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